

U.S. Application No. 09/738,742

Attorney Docket No. C058

REMARKSAmendments to the Claims

Claims 1, 2, 5-12, 15-27, and 30-36 are pending in the present application. Applicants have amended claim 16 to make the claim more clear. Support for this amendment can be found on page 37, lines 2-5.

Claim 24 has been amended to recite appropriate chemical names in addition to various trademark names. In addition, Applicants have amended claim 24 to correct a typographical error in the term "HMR3647" to the correct term "HMR-3647".

Claim 30 has been amended to more clearly define a subset of the compounds of formula 1 and 2. Support for this amendment can be found in previously filed claim 30 and throughout the specification. See e.g. page 23, line 15 through page 24, line 1.

Claims 8, 9, 17, 25, 34 and 36 were amended to fix typographical errors or to correct Markush style claim language. Support for the amendments to claims 8, 9, 17, 25, 34 and 36 can be found in the original and previously filed claims.

Accordingly, upon entry of the instant amendments, claims 1, 2, 5-12, 15-27, and 30-36 will be pending in this application. None of the amendments introduces new matter.

Provisional Obviousness-Type Double Patenting Rejection

Claims 1 and 2 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the co-pending United States patent application 09/739,535.

Applicants will address compliance with 37 C.F.R. §§ 1.321(b) and (c) upon an indication that the claims in the instant application are allowable.

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Rejections under 35 U.S.C. § 112, first paragraph

Claim 30 stands rejected under 35 U.S.C. § 112, first paragraph. The Office Action states that the specification does not explain how to convert a compound of claim 27 into a compound of claim 1 or 2.

Applicants have amended claim 30 to recite a method of using the compounds of claim 27 to prepare a compound described by a subgenus of the compounds of claim 1 or 2.

Claims 16-26 and claim 36 stand rejected under 35 U.S.C. § 112, first paragraph, “as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.”

The Office Action states that the specification is insufficient to support that portion of the claim drawn to the method of preventing a bacterial infection. Applicants have amended claim 16 to delete the term “preventing”, thus overcoming this objection.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 16-26, 30 and 36 stand rejected under 35 U.S.C. § 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”

The Office Action states that claim 16 is indefinite as to the process steps and endpoint.

Applicants have amended claim 16 to add process steps and an endpoint.

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The Office Action states that in claim 24 various trademark terms may be used, if accompanied by the chemical terms that these names represent.

Applicants have amended claim 24 to recite appropriate chemical names in addition to various trademark names.

The Office Action states that Claim 30 is indefinite as to the process steps.

Applicants have amended claim 30 to recite a method of using the compounds of claim 27 to prepare a compound described by a subgenus of the compounds of claim 1 or 2.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

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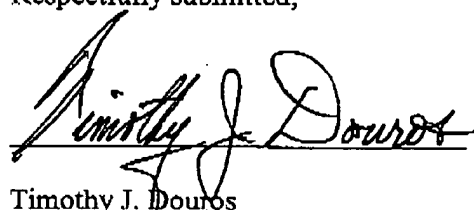
CONCLUSION

For the reasons presented above, Applicants respectfully request reconsideration and prompt allowance of all pending claims. No fee (other than the fee for the petition for a one-month extension) is believed due in connection with the filing of this Amendment. However, the Commissioner is authorized to deduct any deficient amount or credit any surplus amount to Deposit Account No. 50-1986.

Respectfully submitted,

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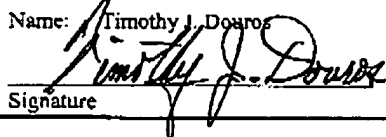
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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence (an Amendment 30 pp. and a Petition for an Extension of Time 1 p.) is being sent via Facsimile to facsimile number (703) 872-9306 to: Assistant Commissioner for Patents, Attention: Examiner Lukton, Washington, DC 20231 on December 8, 2003.

Name: Timothy J. Douros

Signature

December 8, 2003
Sig. Date